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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,550	01/08/2002	Jan Trebesius	(H) 01ICP0235USP	4686
7590 M Robert Kestenbaum 11011 Bermuda Dunes NE Albuquerque, NM 87111				
01/23/2009				
EXAMINER				
THEIN, MARIA TERESA T				
ART UNIT		PAPER NUMBER		
3627				
MAIL DATE		DELIVERY MODE		
01/23/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/869,550

**Applicant(s)**

TREBESIOUS, JAN

**Examiner**

MARISSA THEIN

**Art Unit**

3627

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-7, 9-13 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 9-13, and 15-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 3, 2005 has been entered.

### ***Response to Amendment***

Applicant's "Request for Continued Examination" filed on November 3, 2005 has been considered.

Applicant's "Petition to the Office" (Petition to Withdraw the Holding of Abandonment under 37 CFR 1.181) filed on April 30, 2008 has been granted on November 10, 2008.

Applicant's remark by virtue of amendment to the specification has overcome the Specification rejection.

Claims 1, 7, and 15 are amended. Claims 2, 8 and 14 are canceled. Claims 1, 3-7, 9-13, and 15-28 are pending in this application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-7, 9-13, 15-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3-6, and 16-22 are not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble of the claim refers to a system claim, and the body of the claim discusses the specifics of the method steps and a system.

Claims 7, 9-13 and 23-28 are not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble of the claim refers to a method and a system claim, and the body of the claim discusses the specifics of the method steps. Examiner suggests removing the language "operating the online ordering system as claimed in claim 1".

Claims 9-13 and 23-25 are rejected as being dependent on claim 7 as discussed above.

Claim 15 is not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble of the claim refers to a system claim, and the body of the claims the method of claim 7 which discusses the specifics of the method steps. Examiner suggests removing the language "for carrying out the method as claimed in claim 7".

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7, 9-13, 15 and 23-25 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the "response" step with an absence of a machine in the rest of the body of the claim fails to make the claim statutory under 35 USC 101. The use of a particular machine in the claims is nominal. Thus, the claims are non-statutory. For example, "user input.." steps needs a particular machine.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3-6, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,845,263 to Camaisa et al. in view of U.S. Patent No. 6,700,674 to Otsuka et al.**

Regarding claim 1 and 17-21, Camaisa discloses an online ordering system for food outlets, comprising:

- at least a first computer system which is accessible via the Internet under at least one domain, in which data on food outlets are stored on which a program runs (see at least Figures 1-2; col. 5, lines 37-67; col. 6, lines 38-52; col. 7, lines 24-35);
- in each case a communication connection which can be established at least temporarily between the computer system and at least a large number of all the food outlets covered (see at least Figures 1-2; col. 5, lines 37-67; col. 7, lines 24-35); and
- connects an output device and/or display device at the food outlets to the first computer system (see at least Figures 1-2; col. 5, lines 37-67; col. 7, lines 24-35).

However, Camaisa does not explicitly disclose generating an email whereby a fax is generated from said e-mail by said system or a connected system or a connected

fax server; the fax machine; the transmission of said fax to said fax machine; the system sends a message to the food outlet with the suggestion to check the fax machine if there are problems in the transmission of the order to the food outlet; e-mail, fax message to another fax machine; and notified on an unsuccessful attempt to fax the order. Camaisa discloses remote ordering capabilities of the system allow for users on home PC's to access restaurant information through Wide Area Database server. This access will also be available through fax and modem line, Internet, fiber optics, etc. (Col. 16, lines 40-45). Furthermore, Camaisa discloses the communication can be done through e-mail (col. 13, lines 32-34). The customers can place orders using a home computer (col. 13, lines 42-43).

Otsuka, on the other hand, teaches generating an email whereby a fax is generated from said e-mail by said system or a connected system or a connected fax server; the fax machine; the transmission of said fax to said fax machine; the system sends a message to the food outlet with the suggestion to check the fax machine if there are problems in the transmission of the order to the food outlet; e-mail, fax message to another fax machine; and notified on an unsuccessful attempt to fax the order (col. 1, lines 62-col. 2, line 12; col. 12, lines 22-39; Figure 1; col. 10, lines 16-17; Figures 9a-9b; col. 18, lines 4-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Camaisa, to generating an email whereby a fax is generated from said e-mail by said system or a connected system or a connected fax server; the fax machine; the transmission of said fax to said

fax machine; the system sends a message to the food outlet with the suggestion to check the fax machine if there are problems in the transmission of the order to the food outlet; e-mail, fax message to another fax machine; and notified on an unsuccessful attempt to fax the order, as taught by Otsuka, in order to improve the rate of arrival of the information at the addressee (Otsuka, col. 4, lines 66-67).

Regarding claims 3-6, Camaisa discloses an interactive program runs on the first computer system (see at least col. 3, lines 43-61; col. 5, lines 59-62); a second computer system, which is connected to the Internet, can communicate with the first computer system (see at least Figures 1-2; col. 5, lines 37-67; col. 7, lines 24-35); the second computer system comprises a fax server (see at least col. 10, lines 19-23; col. 16, lines 43-44); and the program comprises at least one prompted user program and one unprompted user program (see at least col. 5, line 59 – col. 6, line 3).

**Claims 7, 9-13, 15 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,845,263 to Camaisa et al. in view of U.S. Patent No. 5,991,739 to Cupps et al. and in further view of U.S. Patent No. 6,700,674 to Otsuka et al.**

Regarding claims 7 and 23-27, Camaisa discloses a method of operating an online ordering system, comprising:

- display of the start page (see at least Figure 3; Figures 6-7; col. 14, line 45-col. 15, line 3);
- response of the system to the use input on the basis of the stored data on the food outlets and display of the food outlets;



- user input in such a way that one of the displayed food outlets is selected,
- response of the system to the user input on the basis of the stored data on the food outlets and display of the items of food offered by the food outlet selected;
- user input in such a way that one of the displayed items of food is selected from a table reservation is made; and
- response of the system to the user input and transmission of the order to the food outlet selected.

However, Camaisa does not disclose a geographical specification. Camaisa discloses an interactive visual ordering system to provide customers of a business with remote access of product information, including product description, prices, and sales and delivery information (col. 7, lines 12-15). Furthermore, Camaisa discloses order information is placed automatically for processing, wherein the order is placed and delivered in a timely manner (col. 13, lines 35-39). Cupps, on the other hand, teaches the geographical specification (see at least Figure 11, ref. no. 302; col. 6, lines 19-30; col. 6, lines 45-56; col. 9, lines 48-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Camaisa, to include the geographical specification, as taught by Cupps, in order to determine whether a customer is within a specified geographic area of a restaurant's area (Cupps col. 7, lines 1-4).

The combination of Camaisa and Cupps does not explicitly disclose generating an email whereby a fax is generated from said e-mail by said system or a connected system or a connected fax server; the fax machine; the transmission of said fax to said

fax machine; the system sends a message to the food outlet with the suggestion to check the fax machine if there are problems in the transmission of the order to the food outlet; e-mail, fax message to another fax machine; and notified on an unsuccessful attempt to fax the order. The combination discloses remote ordering capabilities of the system allow for users on home PC's to access restaurant information through Wide Area Database server. This access will also be available through fax and modem line, Internet, fiber optics, etc. (Camaisa, Col. 16, lines 40-45). Furthermore, the combination Camaisa discloses the communication can be done through e-mail (Camaisa, col. 13, lines 32-34). The customers can place orders using a home computer (Camaisa, col. 13, lines 42-43).

Otsuka, on the other hand, teaches generating an email whereby a fax is generated from said e-mail by said system or a connected system or a connected fax server; the fax machine; the transmission of said fax to said fax machine; the system sends a message to the food outlet with the suggestion to check the fax machine if there are problems in the transmission of the order to the food outlet; e-mail, fax message to another fax machine; and notified on an unsuccessful attempt to fax the order (col. 1, lines 62-col. 2, line 12; col. 12, lines 22-39; Figure 1; col. 10, lines 16-17; Figures 9a-9b; col. 18, lines 4-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Camaisa, to generating an email whereby a fax is generated from said e-mail by said system or a connected system or a connected fax server; the fax machine; the transmission of said fax to said

fax machine; the system sends a message to the food outlet with the suggestion to check the fax machine if there are problems in the transmission of the order to the food outlet; e-mail, fax message to another fax machine; and notified on an unsuccessful attempt to fax the order, as taught by Otsuka, in order to improve the rate of arrival of the information at the addressee (Otsuka, col. 4, lines 66-67).

Regarding claim 9, Camaisa discloses displaying various categories of food; user input of a specific category of the categories of food displayed; and response of the system to the user input on the basis of the stored data on the food outlets and display of the food outlets which offer the category of food selected (see at least Figure 3; Figures 7-9; col. 12, lines 12-26; col. 14, line 65 – col. 15, line 25).

Regarding claim 10, Camaisa transmitting a message to the orderer on the success/failure of passing on the order to the food outlet (see at least col. 15, lines 18-20).

Regarding claim 11, Camaisa discloses display of price categories of the food outlets; user input of a specific category of the price categories displayed; and response of the system to the user input on the basis of the stored data on the food outlets and display of the food outlets which is in the price categories selected (see at least Figure 3; Figures 7-9; col. 7, lines 12-15; col. 12, lines 12-26; col. 14, line 65 – col. 15, line 25).

Regarding claims 12-13, Camaisa discloses user input of a delivery time, delivery address and storage (see at least col. 7, lines 12-15; col. 9, lines 27-29; col. 13, lines 35-39).

Regarding claim 15, the combination substantially discloses the claimed invention, however, the combination does not explicitly disclose generating an email whereby a fax is generated from said e-mail by said system or a connected system or a connected fax server; the fax machine; the transmission of said fax to said fax machine; and the system sends a message to the food outlet with the suggestion to check the fax machine if there are problems in the transmission of the order to the food outlet. The combination discloses remote ordering capabilities of the system allow for users on home PC's to access restaurant information through Wide Area Database server. This access will also be available through fax and modem line, Internet, fiber optics, etc. (Camaisa, Col. 16, lines 40-45) Furthermore, the combination discloses the communication can be done through e-mail (Camaisa, col. 13, lines 32-34). The customers can place orders using a home computer (Camaisa, col. 13, lines 42-43).

Otsuka, on the other hand, teaches generating an email whereby a fax is generated from said e-mail by said system or a connected system or a connected fax server; the fax machine; the transmission of said fax to said fax machine; and the system sends a message to the food outlet with the suggestion to check the fax machine if there are problems in the transmission of the order to the food outlet (col. 3, lines 21-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include generating an email whereby a fax is generated from said e-mail by said system or a connected system or a connected fax server; the fax machine; the transmission of said fax to said

fax machine; and the system sends a message to the food outlet with the suggestion to check the fax machine if there are problems in the transmission of the order to the food outlet, as taught by Otsuka, in order to improve the rate of arrival of the information at the addressee (Otsuka, col. 4, lines 66-67).

**Claims 16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,845,263 to Camaisa et al. and U.S. Patent No. 6,700,674 to Otsuka et al., as applied to claim 1 above, and further in view of U.S. Patent No. 6,173,043 to Finnigan.**

The combination of Camaisa and Otsuka substantially discloses the claimed invention, however, the combination does not explicitly disclose the voice phone message and electronic voice by telephone.

Finnigan, on the other hand, teaches the voice phone message and electronic voice by telephone (abstract; col. 2, lines 8-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include the voice phone message and electronic voice by telephone, as taught by Finnigan, in order to control the transmission of message data in such systems (Finnigan, col. 1, lines 9-10).

**Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,845,263 to Camaisa et al., U.S. Patent No. 5,991,739 to Cupps et al. and U.S. Patent No. 6,700,674 to Otsuka et al., as applied to claim 7 above, and further in view of U.S. Patent No. 6,173,043 to Finnigan.**

The combination of Camaisa, Cupps and Otsuka substantially discloses the claimed invention, however, the combination does not explicitly disclose the voice phone message and electronic voice by telephone.

Finnigan, on the other hand, teaches the voice phone message and electronic voice by telephone (abstract; col. 2, lines 8-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include the voice phone message and electronic voice by telephone, as taught by Finnigan, in order to control the transmission of message data in such systems (Finnigan, col. 1, lines 9-10).

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-7, 9-13, and 15-28 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARISSA THEIN whose telephone number is (571)272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. T./  
Examiner, Art Unit 3627  
January 21, 2009

/Ramsey Refai/  
Examiner, Art Unit 3627